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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,064	10/01/2003	Stephane Caron	PC23216A	8109

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EXAMINER

COPPINS, JANET L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/677,064

Applicant(s)

CARON ET AL.

Examiner

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) Group I cmpds is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/19/04 11/26/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-13 are pending in the instant application.

Information Disclosure Statement

2. Applicants' Information Disclosure Statements, filed July 19, 2004 and November 26, 2004, have been considered by the Examiner. Please refer to the signed copies of Applicants' PTO-1449 forms submitted herewith.

Election/Restrictions

3. The Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. For these reasons provided below, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, in part, drawn to a process of preparing a compound of formula V, wherein "G" is as defined in the second paragraph of claim 1, classified in various subclasses of class 546.
- II. Claims 1-3, 8, and 11, in part, drawn to a process of preparing a compound of formula V, wherein "G" is a group of the formula (A), on the second page of claim 1, classified in various subclasses of class 546.

The above Groups represent general areas wherein the inventions are independent and distinct, each from the other because of the following reasons:

4. Inventions I and II are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as

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claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the claims are directed to two different processes of preparing compounds according to formula (V), based on the definition of "G."

5. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Israel Nissenbaum, Reg. No. 27,582, on Friday, June 16, 2006, a provisional election was made **without** traverse to prosecute the invention of Group II, claims 1-3, 8, and 11, in part, drawn to a process of preparing a compound of formula V, wherein "G" is a group of the formula (A). Affirmation of this election must be made by applicant in replying to this Office action. Accordingly, claims 1-13, wherein "G" is defined in the second paragraph of claim 1, withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 1-3, 8, and 11, in part rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 1 recites the limitation "2-amino piperidine ring depicted in structure I above" in line 7 of page 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear what is meant by "structure I above" since none of the formulae have been labeled "I" but the Examiner assumes Applicants are referring to the compounds of formula V, in the first paragraph of the claim. Furthermore, Applicants' refer to a "piperidine" ring, however, this is incorrect terminology since the only "2-amino" moiety present in the claim is the 2-amino-*pyridyl* ring of structure V. The Examiner warns that the only 2-amino moiety present in the Specification is also a 2-amino-*pyridyl* moiety, yet has also been labeled as "2-amino-piperidine," please see page 3, line 14. Applicants should exercise caution when addressing this rejection, since the Specification does not enable piperidine rings, as it only teaches 2-amino-pyridine rings.

(b) Claims 2, 3, 8, and 11 are rejected under 35 U.S.C. 112, second paragraph for being dependent on a rejected indefinite base claim.

Conclusion

10. In conclusion, claims 1-13 are pending in the instant application, claims 1-13 in part wherein G is defined as in the second paragraph of claim 1 are currently withdrawn from consideration, claims 1-3, 8, and 11 are rejected (wherein G is "A").

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Telephone Inquiry

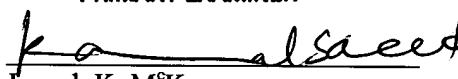
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
June 26, 2006

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

for 
Joseph K. McKane
SPE, Art Unit 1626